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10/645,220

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Jay G. Geertsen

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EXAMINER

SAINDON, WILLIAM V

ART UNIT

PAPER NUMBER

3623

MAIL DATE

DELIVERY MODE

12/23/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/645,220

Applicant(s)

GEERTSEN ET AL.

Examiner

WILLIAM V. SAINDON

Art Unit

3623

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 29-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 29-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. The following FINAL Office Action is in response to Applicant's submission received August 28, 2008. Claims 1-14 were amended. Claims 15-28 were canceled. Claims 29-33 were added. Therefore, claims 1-14 and 29-33 are pending.

### ***Response to Arguments***

2. Applicant's arguments with respect to the claims have been considered but are moot in view of the new grounds of rejection.

### ***Claim Rejections - 35 USC § 101***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The steps recited do not qualify as a statutory process. In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

The claims are not tied to another statutory class. The steps recited either do not require a particular apparatus (e.g. a particular computer), or only mention a nominal recitation of a computer (e.g. for nominal data input/output). Therefore, the claims are non-statutory.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 7 recites "the preference" but no such preference has been previously claimed.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-14 and 29-33 are rejected under 35 U.S.C. 102(b) as being barred by prior public disclosure, sale, and/or use. In the reply filed August 28, 2008, on page 13, Applicants directed Examiner to the archive.org website regarding NEXT-m. Applicant was disclosed in March 2000, which is more than a year before the effective filing date

of the invention. The website discloses the sale of NEXT-m. NEXT-m provides "event-driven alerts" (reminders) that are text messages. Therefore, NEXT-m discloses the present invention and is evidence of an on-sale/public disclosure bar.

9. An issue of public use or on sale activity has been raised in this application. In order for the examiner to properly consider patentability of the claimed invention under 35 U.S.C. 102(b), additional information regarding this issue is required as follows:

Please provide all materials relevant to NEXT-m. Include materials such as marketing materials, sales brochures, product demonstrations, product manuals, product specifications, and the like. Please limit the disclosure to materials relating to versions of NEXT-m available before the filing date of this application.

Please specify in detail the difference(s) (if any) between NEXT-m and Smile Reminder, with reference to particular claim limitations.

Applicant is reminded that failure to fully reply to this requirement for information will result in a holding of abandonment.

The Examiner notes Applicant should not hesitate to contact him with any questions regarding these requests.

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruckdashel (US 6,038,542) in view of Official Notice.

**As to claim 1, Ruckdashel discloses a method comprising:**

scheduling an appointment for a first patient in a reminder scheduler (see Fig. 5, item 501);

reading a plurality of patient records, the plurality of records comprising first and second records (see Fig. 9, noting the system reads records regarding the proper notification time);

identifying appointment data of the first patient, the first record comprising the appointment data of the first patient, wherein the appointment data indicates the scheduled appointment for the first patient (see col. 5, lines 24-39, noting the user's appointment is identified);

identifying a telephone number of the first patient, the first record comprising the telephone number of the first patient (see id., noting the user's telephone number is identified);

creating a first message, the first message comprising the appointment data of the first patient (see id., noting the user's wireless messaging device or pager is used, these devices both receive text messages);

sending the first message to the telephone number of the first patient (id.);

Ruckdashel discloses more than one user (see Fig. 4).

Ruckdashel does not explicitly disclose that the patient records were from a file exported from a practice management system of a dental business, nor does Ruckdashel explicitly disclose the use of text messages (although the wireless messaging device may be the same). However, the Examiner takes Official Notice that it is old and well known to send text messages as appointment reminders and to use data imported from another application. Therefore, it would have been obvious to a person having ordinary skill at the time of invention to modify the appointment reminder system of Ruckdashel with the specific requirements that the data was imported and that the reminders are sent via text message. These modifications would provide the predictable result of keeping up with technology, and using flexible data sources according to known, predictable methods.

**As to claim 2,** Ruckdashel fails to explicitly disclose reading patient data posted via an https socket. Ruckdashel clearly discloses the use of a server remote from other clients, but fails to specify the communication protocol. However, the Examiner takes

Official Notice that it is old and well known to read data from an https socket. Therefore, it would have been obvious to a person having ordinary skill in the art at the time of invention that Ruckdashel could receive data from an https socket for the purpose of receiving data remote from the scheduling computer using commonplace methods.

**As to claim 3**, Ruckdashel discloses sending reminders to each patient (see title - system for notifying an individual of a previously scheduled event).

**As to claim 4**, Ruckdashel discloses validating a name of the first patient (see Fig. 4). Ruckdashel fails to explicitly disclose that the name also has a unique identifier. However, the Examiner takes Official Notice that it is old and well known to use unique identifiers. Therefore, it would have been obvious to a person having ordinary skill in the art at the time of invention to attach a unique ID to each person in the system of Ruckdashel, for the purpose of creating unique records, as is standard practice.

**As to claim 5**, Ruckdashel fails to explicitly disclose importing data. However, the Examiner takes Official Notice that it is old and well known to import data, especially via web browsers. Therefore, it would have been obvious to a person having ordinary skill in the art at the time of invention to modify Ruckdashel with a data import for the purpose of allowing the system to receive data from other systems.

**As to claim 6**, Ruckdashel discloses configuring message setting of the text message based a preference of the patient (see Fig. 5, item 505, the user can select to not receive text messages at all).



**As to claim 7**, Ruckdashel discloses the preference of the patient comprises a time that the text message will be sent (see col. 5, lines 40-51; col. 6, lines 11-17, noting various configuration options are available based on user preference).

**As to claims 8-11**, Ruckdashel discloses notification, but fails to explicitly disclose the textual makeup of the notification. Clearly sending a blank message would not be useful. Neither would creating a new message from scratch each time. The Examiner takes Official Notice that it is old and well known to use templates as a starting point for notifications, within which the time and relevant parties are identified. These same template tokens are used in standard paper reminders as well, such as the postcards sent by dentists to patients that identify the patient, time of appointment, and practice. Automating these known things are clearly predictable and an obvious modification to Ruckdashel. Therefore, it would have been obvious to a person having ordinary skill in the art at the time of invention to specify that the notifications in Ruckdashel used a template with tokens for filling in the relevant information, such as name, time, and practice.

**As to claim 12**, Ruckdashel discloses a server in communication with clients via a lan/wan that share the scheduling information. Ruckdashel fails to explicitly disclose that the patient records are read by a web server. However, the Examiner takes Official Notice that it is old and well known to use web servers to gather information. Therefore, it would have been obvious to a person having ordinary skill in the art at the time of invention to specify that the records in Ruckdashel were read by a web server for the purpose of exchanging data over the internet.

**As to claims 13 and 14**, Ruckdashel discloses retrieving local service provider data and determining a local service provider gateway (see Fig. 7, noting that a telephone number is local service provider data acting as a gateway to communicating with the device).

**Claims 29-33** are rejected for the same or similar reasons as claims 1-14.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Glazer et al. (US 2002/0032588) discloses a patient reminder system using text messages.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM V. SAINDON whose telephone number is (571)270-3026. The examiner can normally be reached on M-F 7:30-5; alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/wvs/

/Beth V. Boswell/  
Supervisory Patent Examiner, Art Unit 3623

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